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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,708	08/24/1999	SON NGUYEN KIM	49322	5584

7590 02/28/2002

MESSRS KEIL & WEINKAUF  
1101 CONNECTICUT AVE NW  
WASHINGTON, DC 20036

EXAMINER

WILLIS, MICHAEL A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/382,708

Applicant(s)

KIM ET AL.

Examiner

Michael A. Willis

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1 and 5-12.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER

  
Michael A. Willis

Continuation of 3. Applicant's reply has overcome the following rejection(s): Based on applicant's amendment, the rejection of claims 8 and 9 under 35 USC 112, 2nd paragraph is withdrawn..

Continuation of 5.

Claims 5-9 are rejected under 35 USC 103(a) as being unpatentable over Mita et al (US Pat. 5,278,269) in view of Ribba (US Pat. 4,800,220) for reasons as stated in a previous Office Action.

In response to the Examiner's position that the polymers of the instant application are not strictly anionic or anionogenic, Applicant argues that the components of claim 5, section m are in incorporated form, and as such they are reacted with an isocyanate group to yield a urea linkage rather than existing as cationic amines. Therefore, the polymers of the present invention are anionic or anionogenic such that the cationic polymers of Mita are not relevant to the present invention. However, it is the position of the examiner that applicant relies on a feature that is not claimed. The claims do not state a limitation of anionic or anionogenic polymers. It is noted that the claims are drawn to polymers that comprise various monomers. A reasonable interpretation can include additional monomeric units, including cationic monomers. Finally, it is the position of the examiner that "in incorporated form" does not mean that the terminal amine groups of claim 5, section m are necessarily reacted with isocyanate groups to yield urea linkages. Rather, it is the position of the examiner that "in incorporated form" means that the monomeric units are covalently attached at some point, but not necessarily at the terminal amino or isocyano functionality.

Applicant concedes that components (a) and (d) of the present invention fall within the general definition of components (c) and (d) taught by Ribba, but argues that Ribba does not teach the combination of 40-80% t-butyl(meth)acrylate (a) and 1-30% component (d). Applicant argues that none of the working examples of Ribba contain t-butyl(meth)acrylate monomers and there is no teaching of a preference for components (a) and (d) of the present invention. Applicant argues that the examples of the present application show the criticality of the addition of component (d). It is the position of the examiner that Ribba specifically teaches the use of t-butyl methacrylate (see col. 4, line 35), higher alkyl esters such as stearyl methacrylate (col. 4, line 38), and mixtures (see col. 4, line 40). The weight percentages can be achieved through routine optimization.

Claims 1, and 5-12 are rejected under 35 USC 103(a) as being unpatentable over Ribba (US Pat. 4,800,220) in view of Mori et al (JP 1213221) for reasons as stated in a previous Office Action. New claims 11 and 12 are included in the rejection since they contain subject matter that was previously part of claims 8 and 9. Applicant repeats the argument that Ribba fails to suggest the combination of components (a) and (d) of the present invention. Applicant further argues that Mori does not describe polymers on the basis of t-butyl (meth)acrylate, but rather deliberately excludes t-butyl (meth)acrylate. In response, it is the position of the examiner that Mori's deficiency with respect to t-butyl (meth)acrylate is irrelevant due to the fact that Ribba specifically teaches the use of t-butyl methacrylate (see col. 4 line 35). With respect to applicant's arguments regarding the deficiencies of Ribba alone, it is the position of the examiner that it is the combination of the references that renders the present invention obvious rather than either reference alone.